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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/103,110 06/23/98 ESKILDSEN

S 042390.P5444

MM91/0816
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EXAMINER

DINH, T

ART UNIT

PAPER NUMBER

2841

DATE MAILED:

08/16/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/103,110

Applicant(s)

ESKILDSEN ET AL.

Examiner

Tuan T Dinh

Art Unit

2841

The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2000.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 14) ☒ Notice of References Cited (PTO-892)
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.

- 17) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: _____.

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DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities:

Applicant is required to provide the missing data on page 1, line 8.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-2 are rejected under 35 U.S.C. 102(a) as being anticipated by Wakabayashi et al (5,659,459).

As to claim 1, Wakabayashi discloses an IC card (503) as shown in figures 1-11 comprising an IC package (550) having multiple leads (551) extending away from the IC package and not in contact to IC package. A casing (100, 120) encases the package without the use of the printed circuit board and connector (column 10, lines 1-5, column 16, lines 33-41).

As to claim 2, Wakabayashi discloses an IC card as shown in figure 1 wherein the casing having a front surface including a front opening.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wakabayashi et al in view of Banjo et al (U. S. Patent 4,926,034).

As to claims 3 and 4, Wakabayashi discloses all of the limitations of claimed invention, except for the IC card having a surface including a back opening, and there are at least one stop at the back opening. Banjo teaches the IC card (100) as shown in figure 4A-4C comprising a bottom surface having a bottom opening (2) and including at least one stop (21) at the back opening to hold the IC package in the casing (column 2, lines 62-65, column 3, lines 5-16). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the IC card of Wakabayashi and provide the back surface having an opening including the stop for holding the IC card into the casing as taught by Banjo because it is design choice of the IC card having an opening on the back of the card for insert the card into the casing of the IC card and the stops that has function to hold and secure the card into the casing.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wakabayashi et al in view of Ochi et al (U. S. Patent 5,735,040)

As to claims 5-6, Wakabayashi discloses an IC card and satisfies all of the limitation of the claims, except for the IC card wherein the casing having the bottom surface that has a bottom opening, and the casing has at least one stop at the bottom opening. Ochi shows the IC card (10) having the casing that has the bottom surface including the opening (2a), the casing has at least one stop (20) (column 3, line 65-67, column 4, lines 1-4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the IC card assembly of Wakabayashi and provide the casing of the IC card that has bottom surface including an opening and stop to hold the IC package as taught by Ochi because it is design choice of the IC card having an opening at the bottom of the card for insert the card into the casing of the IC card and the stops that has function to hold and secure the card into the casing.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wakabayashi et al in view of Banjo et al and Ochi et al.

Regarding to claims 7-14, the method steps are necessitated by the IC card structure as it is disclosed by Wakabayashi in view of Banjo and Ochi.

Response to Arguments

Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kodai et al, Ohtsuki, Benjo et al, Obata et al disclose related art

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

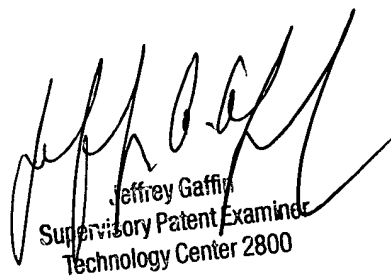
12. Any inquiry concerning this communication or earlier communications from the examiner should be direct to Tuan Dinh whose telephone number is (703) 306-5856 or fax number (703) 305-3431. If attempts to reach the above noted examiner by

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telephone are unsuccessful, the examiner's supervisor, Mr. Jeffrey Gaffin can be reached at (703) 308-3301.

Tuan Dinh

August, 2000



Jeffrey Gaffin
Supervisory Patent Examiner
Technology Center 2800